BRG Brilliant Rubber Goods (M) Sdn Bhd v Santa Barbara Polo & Racquet Club Management Inc (Pendaftar Cap Dagangan Malaysia, interested party) and another case

HIGH COURT (KUALA LUMPUR) — ORIGINATING SUMMONS NOS 24IP-30–11 OF 2013 AND 24IP-31–11 OF 2013
AZIZAH NAWAWI J
25 MARCH 2015

Trade Marks — Application for registration — Dismissal of opposition — Appeals against dismissal — Whether marks were confusingly or deceptively similar — Whether registrar erred in allowing defendant's mark to proceed to registration — Whether plaintiff could rely on grounds not raised before registrar in appeal — Whether ordinary consumers would be deceived or confused — Whether defendant's mark similar to series of marks owned by plaintiff — Whether defendant bona fide proprietor of its mark — Whether registrar erred in failing to give substantial weight and due consideration to plaintiff's goodwill and reputation

The defendant, the management company of the Santa Barbara Polo & Racquet Club ('the Club'), which was based in the USA, had incorporated the name of the Club in its entirety as its mark ('the defendant's mark') and had been using the marks since the 1970's in the USA. The defendant's mark consisted of the words Santa Barbara Polo & Racquet Club as well as a device of a polo player on horseback. The defendant applied to register its mark in respect of two different classes of goods, namely goods in Classes 3 and 16. These applications were accepted by the registrar and advertised in the Government *Gazette*. However, the plaintiff, a Malaysian incorporated company that had been manufacturing and selling a wide range of goods under the Polo marks in Malaysia since 1981, opposed the defendant's applications on, inter alia, the grounds that the defendant's marks were confusingly or deceptively similar to the plaintiff's POLO marks ('the plaintiff's mark') and thus offended s 14 of the Trade Marks Act 1976 ('the Act'). The plaintiff's mark consisted of the word POLO appearing inside a box. The registrar was of the view that the use of the defendant's mark in respect of the stated goods was unlikely to cause confusion or deception to the public. Consequently the registrar dismissed the plaintiff's oppositions and allowed the defendant's applications to register the defendant's mark for goods under Classes 3 and 16. Dissatisfied with the decision of the registrar the plaintiff filed the present appeals, which have been heard together. In this appeal the plaintiff relied on ss 14 and 19 of the Act to support its case that the defendant's marks were deceptively similar. It was the plaintiff's submission that where an earlier mark

is part of a series of marks owned by the same proprietor and that part taken was the common element of this series of marks, ie the word POLO, the likelihood of confusion or deception was very high. In its defence the defendant submitted that visually the two marks were not confusingly or deceptively similar. The defendant submitted that in order to claim ownership of the marks, it was incumbent on the plaintiff to prove ownership through registration or as common law proprietor. The defendant also took objection to the plaintiff relying on s 19 of the Act because this section was not relied as a ground of opposition before the registrar.

Held, dismissing the appeals with costs:

(1) As the plaintiff had not relied on s 19(1) of the Act as a ground of opposition before the registrar, it could not rely on the same in this appeal, which was in effect an appeal from the decision of the registrar. Under s 28(7) of the Act, the grounds of appeal should be limited to the grounds of opposition. Since the plaintiff had not applied for leave of this court to rely on s 19(1) of the Act, no consideration should be afforded to this ground of appeal. However, since the defendant had not taken it as a preliminary objection but proceeded to submit on the merits of the application, s 19(1) of the Act would be considered in the present appeals (see paras 22–24).

(2) The registrar was correct in his findings that the two marks were visually, conceptually or phonetically, clearly different. A comparison of the word POLO in the plaintiff's mark and the same word polo appearing in the defendant's mark did not make the two marks confusingly similar. It is settled law that component features of a mark could not be selected to be compared with selective components of another mark. Thus the word POLO in the plaintiff's mark could not be selected and compared with the word polo in the defendant's mark. Further, the words 'Santa Barbara' and 'Racquet Club' as well as the device of polo player on horseback made the defendant's mark totally different from the plaintiff's mark. The defendant's mark was actually the full name of the Club and was distinctive of the defendant. Therefore, the use of the defendant's mark would not result in confusion and deception in a manner which would offend s 19(1) of the Act (see paras 26–31 & 82).

(3) The plaintiff's opposition under s 14(1)(a) of the Act should also fail. Based on case law it is clear that if the element of the mark (polo or polo player device) was common, then potential consumers would not pay much attention to this common element as they would be looking at the other feature, the uncommon element ie Santa Barbara Polo & Racquet Club. Thus, even if there was a common element in the word 'polo' and the 'polo player device', 'the use of the club name' by the defendant on its mark would not cause any likelihood of confusion. Although the plaintiff

relied on its family of trademarks the only mark that was registered was the POLO mark. For this mark, the plaintiff had not adduced any evidence to show actual use, as the invoices merely refer to polo shirts and pants. There was no actual use with respect to goods in the Classes 3 and 16. Hence the registrar was correct to dismiss the plaintiff's opposition to the registration of the defendant's marks for goods in Classes 3 and 16 (see paras 38, 44–45, 49 & 81).

(4) The bona fide of the defendant in filing the defendant's trademark could not be doubted. Its claim to ownership was justified as it was essentially an encapsulation of the name and emblem of the Club since its establishment in 1911. Therefore, since the defendant's mark was created in 1911 whereas the plaintiff's earliest POLO mark was only registered in 1981, there was no possibility of the defendant copying the plaintiff's mark. Further, in the present case the defendant was not adopting the plaintiff's mark but seeking to register its own trade mark, which was totally different from the plaintiff's (see paras 54 & 58).

(5) Since the plaintiff's mark was different from the defendant's mark the issue of the plaintiff's goodwill and reputation in its business relating to the POLO marks was not relevant. This was because even if the plaintiff, as the proprietor of the POLO mark, had substantial goodwill and reputation, that did not prohibit the defendant from registering the defendant's mark, as it was different from the plaintiff's POLO mark (see paras 63–64).

[Bahasa Malaysia summary

Defendan, syarikat pengurusan Santa Barbara Polo & Racquet Club ('Kelab'), yang berpangkalan di Amerika Syarikat, telah menubuhkan nama Kelab secara keseluruhannya sebagai capnya ('cap defendan') dan telah menggunakan cap tersebut sejak tahun 1970-an di Amerika Syarikat. Cap defendan terdiri daripada perkataan Santa Barbara Polo & Racquet Club begitu juga dengan peranti pemain polo berkuda. Defendan memohon untuk mendaftarkan cap berkenaan dengan dua kelas barangan berbeza, iaitu barang dalam Kelas 3 dan 16. Permohonan ini telah diterima oleh pendaftar dan diiklankan dalam Warta Kerajaan. Walau bagaimanapun, plaintif, sebuah syarikat yang diperbadankan di Malaysia yang telah menghasilkan dan menjual pelbagai barangan di bawah cap Polo di Malaysia sejak 1981, membantah permohonan defendan antara lainnya, atas alasan bahawa cap defendan adalah mengelirukan atau nampak sama dengan cap POLO plaintif ('cap plaintif') dan dengan itu bertentangan dengan s 14 Akta Cap Dagangan 1976 ('Akta'). Cap plaintif terdiri daripada perkataan POLO yang terdapat di dalam kotak. Pendaftar berpendapat bahawa penggunaan cap defendan berkenaan dengan barang yang dinyatakan tidak mungkin menyebabkan kekeliruan atau penipuan kepada orang ramai. Sehubungan dengan itu, pendaftar menolak bantahan plaintif dan membenarkan permohonan defendan untuk mendaftarkan cap defendan

untuk barangan di bawah Kelas 3 dan 16. Tidak berpuas hati dengan keputusan pendaftar, plaintif memfailkan rayuan ini, yang telah didengar bersama. Dalam rayuan ini plaintif bergantung kepada ss 14 dan 19 Akta yang menyokong kesnya bahawa cap defendan secara mengelirukan nampak sama. Adalah hujahan plaintif bahawa jika cap yang lebih awal adalah sebahagian daripada siri cap yang dimiliki oleh pemilik yang sama dan bahawa sebahagiannya diambil adalah elemen biasa siri cap, iaitu perkataan POLO, kemungkinan kekeliruan atau penipuan adalah sangat tinggi. Dalam pembelaannya defendan berhujah bahawa secara visual kedua-dua cap tidak mengelirukan atau nampak sama. Defendan berhujah bahawa untuk menuntut milikan cap, adalah penting bagi plaintif untuk membuktikan milikan melalui pendaftaran atau pemilik common law. Defendan juga membuat bantahan kepada plaintif yang bergantung kepada s 19 Akta kerana seksyen ini tidak dipergantungkan sebagai alasan bantahan di hadapan pendaftar.

Diputuskan, menolak rayuan dengan kos:

(1) Memandangkan plaintif tidak bergantung kepada s 19(1) Akta sebagai alasan bantahan di hadapan pendaftar, ia tidak boleh bergantung kepada seksyen yang sama dalam rayuan ini, yang memberi kesan rayuan terhadap keputusan pendaftar. Di bawah s 28(7) Akta, alasan rayuan seharusnya terhad kepada alasan bantahan. Memandangkan plaintif tidak memohon kebenaran daripada mahkamah ini untuk bergantung kepada s 19(1) Akta, tiada pertimbangan yang seharusnya diberikan kepada alasan rayuan ini. Walau bagaimanapun, memandangkan defendan tidak menggunakannya sebagai bantahan awal tetapi terus mengemukakan merit permohonan, s 19 (1) Akta akan dipertimbangkan dalam rayuan ini (lihat perenggan 22–24).

(2) Pendaftar bertindak tepat dalam dapatannya bahawa kedua-dua cap secara visual, konsep atau fonetik, jelas berbeza. Perbandingan perkataan POLO dalam cap plaintif dan perkataan polo yang sama yang terdapat dalam cap defendan tidak menjadikan kedua-dua cap tersebut secara mengelirukan kelihatan sama. Undang-undang terpakai adalah bahawa ciri komponen cap tidak dapat dipilih untuk dibandingkan dengan komponen terpilih cap lain. Oleh itu, perkataan POLO dalam cap plaintif tidak boleh dipilih dan dibandingkan dengan perkataan polo dalam cap defendan. Selanjutnya, perkataan 'Santa Barbara' dan 'Racquet Club' begitu juga dengan peranti pemain polo yang berkuda menjadikan cap defendan sama sekali berbeza daripada cap plaintif. Cap defendan sebenarnya nama penuh Kelab dan berlainan dengan defendan. Oleh itu, penggunaan cap defendan tidak akan menyebabkan kekeliruan dan penipuan dengan cara yang bertentangan s 19(1) Akta (lihat perenggan 26–31 & 82).

(3) Bantahan plaintif di bawah s 14(1)(a) Akta seharusnya juga gagal. Berdasarkan kes undang-undang adalah jelas bahawa jika unsur cap (polo atau peranti pemain polo) adalah perkara biasa, maka pengguna yang berpotensi tidak akan memberi perhatian yang lebih kepada unsur yang biasa ini kerana mereka akan melihat ciri-ciri lain, unsur luar biasa iaitu Santa Barbara Polo & Racquet Club. Oleh itu, walaupun sekiranya terdapat satu elemen yang sama dalam perkataan 'polo' dan 'peranti pemain polo,' 'penggunaan nama kelab' oleh defendan pada capnya tidak akan menyebabkan sebarang kemungkinan kekeliruan. Walaupun plaintif bergantung kepada cap dagang keluarganya, satu-satunya cap yang telah didaftarkan adalah cap POLO. Untuk cap ini, plaintif tidak mengemukakan apa-apa keterangan yang menunjukkan penggunaan sebenar, memandangkan invois hanya merujuk kepada baju dan seluar polo. Tidak ada penggunaan sebenar berkenaan dengan barang-barang di Kelas 3 dan 16. Oleh itu pendaftar bertindak tepat untuk menolak bantahan plaintif dengan pendaftaran cap defendan untuk barangan dalam Kelas 3 dan 16 (lihat perenggan 38, 44–45, 49 & 81).

(4) Tindakan bona fide defendan dalam memfailkan cap dagangan defendan tidak boleh diragui. Tuntutannya ke atas milikan adalah wajar kerana tuntutannya secara asas menggabungkan nama dan lambang Kelab sejak penubuhannya pada tahun 1911. Oleh itu, memandangkan cap defendan telah dicipta pada tahun 1911 manakala cap POLO terawal plaintif hanya didaftarkan pada tahun 1981, tidak terdapat kemungkinan bahawa defendan meniru cap plaintif. Di samping itu, dalam kes ini defendan tidak mengguna cap plaintif tetapi memohon untuk mendaftarkan cap dagangan sendiri, yang sama sekali berbeza daripada plaintif (lihat perenggan 54 & 58).

(5) Memandangkan cap plaintif adalah berbeza daripada cap defendan, isu nama baik plaintif dan reputasi dalam perniagaannya berhubung dengan cap POLO adalah tidak relevan. Ini adalah kerana meskipun plaintif, sebagai pemilik cap POLO, mempunyai nama baik dan reputasi yang besar, itu tidak menghalang defendan daripada mendaftar cap defendan, memandangkan capnya adalah berbeza daripada cap POLO plaintif (lihat perenggan 63–64).]

Notes

For cases on application for registration in general, see 12(2) *Mallal's Digest* (5th Ed, 2015) paras 2572–2602.

Cases referred to

10 Royal Berkshire Polo Club Trade Mark, Re [2001] RPC 643 (refd)

Dabur India Ltd v Nagasegi Sdn Bhd & Ors [2011] 7 MLJ 522; [2011] 10 CLJ 134, HC (refd)

Eastman Photographic Materials Company Ltd v Comptroller-General of Patents

Designs and Trade Marks, Solio Case [1898] AC 571, HL (refd)
Eriktico v Erector [1935] 52 RPC 136 (refd)
Harrods Ld's Application (1935) 52 RPC 65 (refd)
Industria De Diseno Textil, SA v Edition Concept Sdn Bhd [2005] 3 MLJ 347, HC (refd)
Inland Revenue Commissioners v Muller & Co's Margarine, Ltd [1901] AC 217, HL (refd)
Nokia Corporation v Truong and others [2005] 66 IPR 511, FC (refd)
Polo/Lauren Co LP, The v Shop-In Department Stores Pte Ltd [2006] 2 SLR 690, CA (refd)
The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2005] 4 SLR 816, HC (refd)
Tohtonku Sdn Bhd v Superace (M) Sdn Bhd [1992] 2 MLJ 63, SC (refd)
Vitamins Ltd's Application, Re [1956] RPC 1 (refd)
Walton International Ltd v Yong Teng Hing (b/s Hong Kong Trading Co) [2011] 5 MLJ 397; [2010] 8 CLJ 802 (refd)
Yong Teng Hing b/s Hong Kong Trading Co & Anor v Walton International Ltd [2012] 6 MLJ 609; [2012] 6 CLJ 337, FC (refd)

Legislation referred to

Trade Marks Act 1938 [UK] s 17(1)
Trade Marks Act 1976 ss 10, 10(2A), 14, 14(1), (1)(a), 19, 19(1), 25(1), 28(7), 67, 70B, 82(2)
Trade Marks Regulations 1997 reg 13B

Michael Soo (Wendy Lee with him) (Shook Lin & Bok) for the plaintiff.
HL Choon (OL Leong with him) (Raja, Daryl & Loh) for the defendant.

Azizah Nawawi J:

INTRODUCTION

[1] There are two cases before me involving the same parties but different classes of goods. Since the facts are the same, the parties have agreed that these cases are to be heard together.

[2] Enclosures 1 of 24IP-30–11 of 2013 and 24IP-31–11 of 2013 (respectively) is an appeal against the decision of the registrar dated 24 September 2013 which allowed the registration of the defendant's mark in Class 3 and 16 and dismissed the objection raised by the plaintiff. The registration is effective from the filing date, 20 October 2003.

[3] After hearing the parties, all the applications have been dismissed with costs.

THE SALIENT FACTS

[4] The plaintiff is a company incorporated in Malaysia. It has, by itself or its licensees, been manufacturing and selling a wide range of goods under the Polo marks in Malaysia and had obtained registration for its Polo marks, namely the Polo mark, in Classes 25 and 28 in Malaysia on 28 August 1981:

Trademark No.	Mark	Class
M/091943	Polo	28
M/091944	Polo	25

[5] The defendant is the management company of the Santa Barbara Polo & Racquet Club ('the Club'), and is based in California, United States Of America ('USA'). The Club was officially established as a member of the United States Polo Association in 1911 and is the third oldest polo club in the USA.

The defendant's mark, has incorporated the name of the Club in its entirety. The defendant's mark represents the Club.

[6] The defendant has been using the defendant's mark since 1970's in the United States of America. In Malaysia, the defendant has filed and obtained the following trade mark registrations for the defendant's mark on 3 March 1993:

No	Application No.	Trade Mark	Class	Specification of Goods
1.	93001339		25	Clothing, including boots, shoes and slippers; ties, socks, undergarments and handkerchiefs

2.	93001337		18	Leather and imitations of leather, articles made from these materials and not included in other classes; skins, hides, trunks and travelling bags, umbrellas, parasols and walking sticks; whips, harness and saddlery

[7] In respect of these cases (24IP-30–11 of 2013 and 24IP-31–11 of 2013), the defendant's marks, which were filed for registration on 20 October 2003, are as follows:

No	Application No.	Trade Mark	Class	Specification of Goods
1.	03014176		3	Aftershave lotions, bath gels, eau de toilette, hair gel, lipstick, lotions, perfume, shampoo (hair) and shower lotion, soap (deodorant), soap for hands, face and body, toothpaste
2.	03014177		16	Stationary type portfolio, stationary, stationary folders, three-ring binders, tissue (facial), writing instrument, writing paper, writing pads

[8] Apart from the above, the defendant's other marks which have been registered are as follows:

Date of Registration	Registration No.	Trade Mark	Class	Specification of Goods
3.3.1993	93001338		9	Optical products included in class 9
3.3.1993	93001337		14	Horological and Chronometric instruments namely watches, clocks and any time keeping instruments; all included in Class 14

[9] The chronology of the defendant's applications under Classes 3 and 16 are as follows:

(a) the applications were accepted by the registrar and advertised in the Government *Gazette* on 8 May 2008 and 21 June 2007 respectively;

(b) the plaintiff filed two notices of opposition to oppose the defendant's application on 10 July 2008 and 22 August 2007 respectively; and

(c) on 24 September 2013, the registrar dismissed the plaintiff's oppositions and allowed the defendant's application to register the defendant's mark under Classes 3 and 16.

[10] Being dissatisfied with the registrar's decision, the plaintiff files these appeals.

THE FINDINGS OF THE COURT

[11] It is common ground that under s 67 of the Trade Marks Act 1976 ('the TMA 1976'), this court has the power to review, reverse or otherwise vary the decisions of the learned registrar.

[12] It is also common ground that the burden of proof is on the defendant, as the applicant for registration of the defendant's mark, to satisfy the registrar and this court that the said mark is registrable under the TMA 1976. In *Yong Teng Hing b/s Hong Kong Trading Co & Anor v Walton International Ltd* [2012] 6 MLJ 609; [2012] 6 CLJ 337 (FC) Justice Zulkefli Makinudin CJ (Malaya) held at p 619 (MLJ); p 348 (CLJ) as follows:

> [12] It is to be noted in the present case, the respondent filed its notice of opposition before the appellant's mark could be registered. On this point it is our judgment that

A the onus is on the appellant to prove that he is entitled to register the 'GIORDANO' trade mark.

[13] The plaintiff's grounds of appeal are as follows:

B (a) that the registrar failed to find that the defendant's marks are confusingly/deceptively similar to the plaintiff's POLO marks and offends ss 14 and 19 of the TMA 1976;

(b) that the registrar failed to find that the defendant is not the bona fide proprietor of the marks under s 25(1) of the TMA 1976;

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(c) that the registrar failed to consider that the plaintiff has acquired goodwill and reputation in its business in relation to the POLO marks and that the POLO marks;

D (d) that the registrar failed to find that the defendant failed to establish the distinctiveness of its marks under s 10 of the TMA 1976;

(e) that the registrar had erred in law and/or in fact in holding that use of the defendant's mark by the defendant is unlikely to damage the plaintiff's interests;

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(f) that the registrar had erred in law and/or in fact in holding that the plaintiff has no right to prohibit other parties from using the word 'polo' if it used in a affair manner;

F (g) that the registrar failed to hold that the plaintiff's POLO marks are well known marks within the meaning of ss 14(1) and 70B of the TMA 1976 read with reg 13B of the Trade Marks Regulations 1997; and

(h) that the registrar had erred in law and/or in fact in failing to hold that registration and/or use of the defendant's mark by the defendant would

G constitute passing off in common law, contrary to s 82(2) of the TMA 1976.

Issue (i): Whether the registrar had erred in failing to find that the defendant's mark is confusingly and/or deceptively similar to the plaintiff's POLO marks

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[14] It is the submission of the plaintiff that the registrar had erred in law and in facts in allowing the defendant's marks to proceed to registration as the said marks are not entitled to registration under ss 14(1)(a) and 19 of the TMA 1976 by reason of its confusing and/or deceptive similarity to the POLO

I marks.

[15] The plaintiff submits that it has been using the POLO marks in relation to its goods in Malaysia long before the date of application of the defendant's mark, since about the year 1981 when the plaintiff's mark

was registered. This is supported by the evidence of extensive use and promotion of the POLO marks by the plaintiff and/or its licensees which consequently shows that the POLO marks have become distinctive of the plaintiff and its goods in Malaysia.

[16] However, the defendant submits that when comparing the plaintiff's mark and the defendant's mark, they are *not* confusingly or deceptively similar, as can be seen from the following plain visual comparison:

PLAINTIFF'S MARK		DEFENDANT'S MARK
	VS.	

[17] It is trite law that the likelihood of confusion must be considered at the date of the application to register the defendant's mark, which is 20 October 2003 for Classes 3 and 16 (see *Industria De Diseno Textil, SA v Edition Concept Sdn Bhd* [2005] 3 MLJ 347).

[18] In determining whether the defendant's mark is confusingly similar to the plaintiff's mark, the relevant test can be found in the Supreme Court decision of *Tohtonku Sdn Bhd v Superace (M) Sdn Bhd* [1992] 2 MLJ 63, where the court held that:

> The 'test' which Wan Adnan J was referring to were contained in Parker J's judgment in *The Pianotist Co Ltd* in the following terms:
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> > You must take two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trademarks is used in a normal way as a trade mark for the goods of the respective owners of the marks.

[19] The test formulated by the court in the *Pianotist* case, as accepted by our Supreme Court in *Tohtonku*, in determining whether there is any likelihood of confusion can be summarised as follows:

(a) by comparison of the conflicting marks;

(b) by considering the goods/services to which the conflicting marks are to be applied; and

(c) by considering the type of customers of the proprietors of the conflicting marks.

The underlying consideration would be all the circumstances surrounding the usage or proposed usage of the conflicting marks taken as a whole in determining whether there will be any likelihood of confusion.

[20] It must also be emphasised that the circumstances of use to be considered must be with reference to the time the defendant's mark was applied for registration, that is, on 20 October 2003 for Classes 3 and 16. In *Walton International*'s case, which involved an appeal against the registrar's decision to dismiss an opposition against registration for the trade mark 'GIORDANO', the Federal Court held at p 617 (MLJ); p 346 (CLJ):

> At the outset we would like to state here that the relevant date upon which the court has to decide whether the appellant is entitled to register the 'GIORDANO' trade mark in Class 9 is the *appellant's application date* on 25 July 1992

[21] In the present case, the finding of the registrar is as follows:

> Having said the above, I have come to the conclusion that the use of the Applicant's mark in respect of the stated goods is unlikely to cause confusion or deception to the public. The opposition under Section 14(1)(a) has failed.

[22] The plaintiff's submit that the defendant's mark nearly resembles the plaintiff's mark as is likely to cause confusion premised on s 19(1) of the TMA 1976. However, I agree with the defendant that since s 19(1) was not relied as a ground of opposition before the registrar, the plaintiff cannot rely on the same. Therefore, since this is an appeal from the decision of the registrar, the grounds of appeal must to limited to the grounds of opposition. That is why s 28(7) of the TMA 1976 was enacted, so that parties may apply for leave of court in order to expand the grounds of appeal.

[23] Since the plaintiff did not apply for leave of this court to rely on s 19(1), no consideration should be afforded to this ground of appeal.

[24] However, since the defendant did not take it as a preliminary objection but proceeded to submit on the merits of the application, I will proceed to deal with the appeal premised on s 19(1) of the TMA 1976. Section 19(1) of the TMA 1976 reads as follows:

> (1) No trade mark shall be registered In respect of any goods or description of goods —

(a) that is identical with a trade mark belonging to a different proprietor and entered in the Register in respect of the same goods or description of goods or in respect of services that are closely related to those goods; or

(b) that so nearly resembles such a trade mark as is likely to deceive or cause confusion.

[25] Section 19(1) prohibits the registration of a trade mark that is either identical with a trade mark belonging to a different proprietor, or so nearly resembles it as is likely to deceive or cause confusion entered in the register in respect of the same goods or description of goods. In this appeal, the registration of will not be allowed if:

(a) is identical with or so nearly resembling as is likely to deceive and cause confusion; and

(b) that the plaintiff's goods are the same goods or the same description of goods as the respondent's goods.

[26] Having considered the plaintiff's registered mark and the defendant's registered mark, I agree with the finding of the registrar that there is no similarity between the two marks. Visually, conceptually or phonetically, the two marks are clearly different.

[27] Added to that, the plaintiff had not secured any registration for the plain word mark 'Polo'. So what the plaintiff owned is the mark as presented, that is, the word 'polo' inside a box. And even if we are to compare the word 'Polo' in the plaintiff's mark and the same word 'POLO' appearing in the defendant's mark, the same does not make the two marks confusingly similar. On this, the registrar finds as follows:

> ... The Applicant's mark is neither identicai to nor resemble the Opponent's mark
>
> ... It has been decided that the Applicant's mark is neither identicai nor similar to any marks owned by other traders including the Opponent's in respect of goods and there is no likelihood of confusion if the Applicant's mark is used by the Applicant for the said goods ...

[28] In any event, we cannot simply select the word 'polo' in the plaintiff's mark and compare the it with the word 'POLO' in the defendant's mark. The dangers of selecting component feature of a mark and comparing it with selective components of another mark was highlighted in the case of *Eriktico v Erector* [1935] 52 RPC 136 where the court held:

> I do not think it is right to take a part of a word and compare it with a part of the other word; one word must be considered as a whole ... I think it is a dangerous

method to divide the word up and seek to distinguish a portion of it from a portion of the other word.

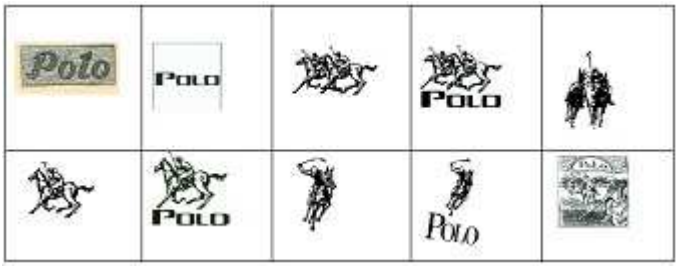
[29] This principle would also extend to comparison of composite marks consisting of two or more different element. In *Nokia Corporation v Truong and others* [2005] 66 IPR 511, it was held that:

> ... it is a composite mark, consisting of two elements — the word 'Nokia' and the trident device. *When identifying trade mark infringement, the issue is whether one or more of the 'essential elements' of the mark have been infringed and this cannot be done by focussing on one element of the mark while completely ignoring other elements* ... (Emphasis added.)

[30] Therefore, I agree with the finding of the registrar. In *Tohtonku*'s case, the Supreme Court agreed with the findings of fact by the trial judge who held that having consider the appearance of the two marks together with their features, it is not likely that ordinary purchasers would be deceived or confused.

[31] Surely, the words 'SANTA BARBARA' and 'RACQUET CLUB' as well as a device of polo player on horseback makes the defendant's marks totally different from the plaintiff's registered marks. Therefore, I am of the considered opinion that the use of the defendant's trade mark would not result in confusion and deception in a manner which would offend s 19(1) of the TMA 1976.

[32] However, it is the submission of the plaintiff that premised on s 14(1)(a) of the TMA 1976, the defendant's mark is also confusingly and deceptively similar to the plaintiff's family of trademarks, namely 'Polo', 'POLO', 'Polo Haus', 'Polo player device', 'Horse device' and/or marks containing the word 'Polo' and/or 'POLO' with or without the 'Polo player device' or 'Horse device' ('the POLO marks'). Some of the said POLO marks are as follows:



[33] Section 14(1)(a) of the TMA 1976 provides as follows:

> 14 Prohibition on registration

(1) A mark or part of a mark shall not be registered as a trade mark — A

(a) If the use of which is likely to deceive or cause confusion to the public or would be contrary to law;

[34] The objective and purpose of s 14(1)(a) is held by the Federal Court in *Walton International Ltd* as follows: B

[25] The objective and purpose of s 14(1)(a) of the Act is to protect the public and consumers from instances of confusion or deception as a result of the use of two similar marks. Thus, under s 14(1)(a) of the Act, a mark shall be refused registration if use thereof is likely to deceive or cause confusion to the public notwithstanding that it is the result of use of an earlier identical or similar mark, whether registered or not in Malaysia and which is being used in relation to good or services which may be different from that sought to be registered. C

D

[35] It is the submission of the plaintiff that where an earlier mark is part of a series of marks owned by the same proprietor and that part taken is the common element of this series of marks, the likelihood of confusion or deception is very high. The reason is that the public might erroneously assume that the later mark is an extension of the series of marks and thus the goods/services have the same source of origin (ie 'another horse from the same stable'). E

[36] In this instance, the plaintiff submits that after making a comparison with the plaintiff's family of Polo marks, the similarities between the defendant's mark and the plaintiff's POLO marks are as follows: F

(a) both have the device of a polo player in motion and/or the concept of polo as their central and distinguishing feature;

(b) device of a polo player used in the defendant's mark is visually and conceptually confusingly similar to that in some of the POLO marks; G

(c) the general impression which will be immediately imparted on the minds of members of the trade and public in viewing the defendant's mark and the POLO marks would be that of a polo player; and

H

(d) the defendant's mark would in all likelihood be referred to as the 'polo mark' in the same manner as the plaintiff's POLO marks as the words 'SANTA BARBARA POLO & RACQUET CLUB' appearing in the defendant's mark is quite a mouthful to pronounce.

I

[37] However, I agree with the defendant that the plaintiff cannot simply make a sweeping statement that the defendant's mark is similar to any of the series of mark owned by the plaintiff. In order to claim ownership of the marks, it is incumbent on the plaintiff to prove ownership through registration, or that

A it is the common law proprietor of those marks.

[38] The plaintiff has to prove that it is the common law owner of all the other marks. They cannot claim monopoly over anything with the word 'polo', the 'horse device' or 'polo player device'. In fact, the registrar made a finding that the plaintiff to show any use of the plaintiff's marks in respect of goods in Classes 3 and 16. In his written decision, the registrar made the following finding:

> The Opponent's evidence only shows the use of the Opponent's marks in respect of goods in Classes 14, 18 and 25, and not for goods in Classes 3 and 16. Nevertheless, even if there is prior use in respect of goods in Classes 3 and 16, the decision of the Registrar in the present proceeding would still be the same ...

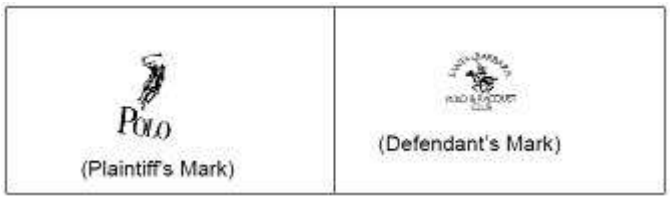
[39] From the applications to file the marks by the plaintiff, only two have been registered, whilst others have been abandoned or pending opposition:

Registered Class 25 & 28		Opposition Pending		Opposition Pending
Abandoned		Opposition Pending/abandoned for class 25 and 18	Request for ex-parte hearing	Request for ex-parte hearing

[40] With regards to its common law ownership, in para 8 of the statutory declaration affirmed on 24 November 2008 by Lim Chin Fei, the plaintiff claims that it's licensee, BRG Top-Line Marketing Sdn Bhd, has been manufacturing and selling shoes, boots and clothing articles bearing the POLO marks since 1989 and exhibited the 'POLO and Horse Device' (exh LCF4).

[41] However, exh 'LCF4' is just a picture of the mark . There is nothing on 'LCF4' to show that this mark has been used on goods since 1981 as claimed by the plaintiff. Exhibit 'LCF5 and 6' are invoices and delivery orders, to show the sale of polo pants and polo shirts. Again there is nothing from these invoices and delivery orders to show that the plaintiff have been selling pants and shirts bearing the 'POLO and horse device' since 1981, before the registration of the defendant's mark.

[42] The possible earliest 'POLO and horse device' mark of the plaintiff in the market can be seen from the advertisement in exh 'LCF7' in the year 1995. However, by just looking at the two marks, they are clearly different:



[43] The main difference can be seen from use of the full name of the Club itself, 'Santa Barbara Polo & Racquet Club'. Being the name of the Club itself, it forms the integral and significant part of the defendant's Mark. I do not agree with the plaintiff's assertion that consumers will refer to the defendant's Mark as the Polo mark as the words 'SANTA BARBARA POLO & RACQUET CLUB' is quite a mouthful to pronounce. To me, the words 'Santa Barbara' is more pronounced that consumers will refer to the same, instead of reference to the word polo.

[44] In the case *Harrods Ld's Application* (1935) 52 RPC 65, it was held that if the element of the mark ('polo' or 'polo player device') is common, then potential consumers will not pay much attention to this common element, as the customers will be looking at the other feature, the uncommon element ('*Santa Barbara Polo & Racquet Club*'). At p 70 of the judgment, the court held that:

> Now, it is a well recognized principle that has to be taken into account in considering the possibility of confusion arising between two trade marks, that, *where those two marks contain a common element which is also contained in a number of other marks in use in the market, such a common occurrence in the market tends to cause purchasers to pay more attention to the other features of the respective marks and to distinguish between them by those other features*. (Emphasis added.)

[45] Therefore, even if there was a common element in the word 'polo' and the 'polo player device', premised on *Harrods* case, the use of the club name by the defendant on its mark will not cause any likelihood of confusion.

[46] The same position was taken in two cases involving the Polo marks dispute. The first case is the United Kingdom decision of *Re 10 Royal Berkshire Polo Club Trade Mark* [2001] RPC 643. This case involved a dispute between the mark '10 Royal Berkshire Polo Club' filed in Class 3 and the 'POLO' family marks registered (five earlier POLO registered marks were cited) by Polo Lauren Company in the same Class 3 for the same and similar goods. It was

held that there is no likelihood of confusion between the two marks despite the fact that both marks are for the same or similar Class 3 goods and both have the same word 'POLO' in them. It was held that:

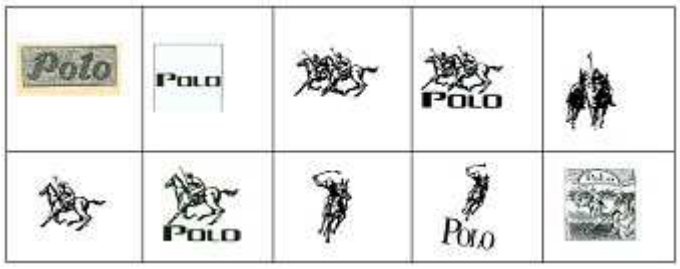
> ... mere association which the pubiic might make between two trade marks as a result of their analogous semantic content is NOT in itself a sufficient ground for concluding that there is a likelihood of confusion even if the earlier mark has a particularly distinctive character (either per se or because of the reputation it enjoys in the market place)
>
> ...
>
> ... I am satisfied that the use of the word POLO as part of the applicant's mark does not capture the distinctiveness of the opponents earlier trademarks. I do not think that people exposed to the use of the applicant's mark would notice that it contained the word POLO without also noticing that it contained the words ROYAL BERKSHIRE and CLUB.

[47] Even if we accept the plaintiff's contention that its family marks already have a reputation in the market (as the 'POLO' family marks registered by Polo Lauren Company), the same is not a sufficient ground to conclude that there is a likelihood of confusion as the customers would also notice the words *Santa Barbara Polo & Racquet Club*.

[48] The other Polo case is a decision of the Singapore Court of Appeal in *The Polo/Lauren Co LP v Shop-In Department Stores Pte Ltd* [2006] 2 SLR 690. In this case, the court held that there is no likelihood of confusion between the registered 'POLO' marks and the defendant's 'POLO PACIFIC' mark. The court held as follows:

> 24. Bearing in mind that 'polo' is a common English word, we are unable to see how it could be said that the sign 'POLO PACIFIC' with its special font and design is similar to the mark 'POLO', except in the broadest sense that one word is common ...
>
> *In any event, for the purpose of determining similarity... one must look at the mark and sign as a whole ... and bearing in mind the actual differences between the two, we cannot see how it can be said that the trial judge was wrong when he held that the sign and the mark are not similar ....*
>
> Indeed, in the light of our finding above that the sign and the mark are not similar, the question of confusion does not arise ... (Emphasis added.)

[49] Therefore, since the plaintiff's family of marks:



A

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are different from the defendant's mark , the registrar is correct to dismiss the plaintiff's opposition to the registration of the defendant's marks in Class 3 and 16. As such, the plaintiff's appeal premised on s 14(1)(a) of the TMA 1976 must fail.

C

Issue (ii): That the registrar erred in failing to find that the defendant is not the bona fide proprietor of the defendant's mark under s 25(1) of the Trade Marks Act 1976

D

[50] Section 25 of the TMA 1976 provides that 'Any person claiming to be the proprietor of a trade mark used or proposed to be used by him may make application to the Registrar for the registration of that mark in the Register in the prescribed manner'.

E

[51] It is the submission of the plaintiff that the defendant has failed to substantiate its claim to proprietorship under s 25(1) of the TMA 1976. There is no evidence that there had been use of the defendant's mark in Malaysia before the date of first use of the plaintiff's POLO marks. Added to that, the defendant has also fail to substantiate its allegation that it has been using the said mark since 1993 as the earliest invoice showing sales of goods bearing the said mark in Malaysia is dated 16 July 2001. There is also no cogent evidence to support any alleged extensive use or promotion of the defendant's mark in relation to goods in Class 3 and Class 16 as documents such as those adduced as exhs 'YKT5' and 'YKT6' do not support the defendant's allegation of long and extensive use, particularly when the monthly sales report exhibited at exh 'YKT5' are in relation to bed linen.

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[52] The plaintiff further submits that the use of the defendant's mark in other jurisdictions around the world is irrelevant to the proceedings before the registrar and this court. Therefore, based on the evidence adduced, it is clear that the plaintiff is the first user and bona fide proprietor of the POLO marks in Malaysia and is entitled to restrain the use of any mark which is confusingly and/or deceptively similar to the POLO marks.

I

[53] *Kerly's Law of Trade Marks and Trade Names* (13th Ed) touched on s

17(1) of the English Trade Marks Act 1938 (corresponding to s 25(1) of the TMA 1976) and observed that:

> claiming that he is entitled to be registered as the proprietor... [the] claim must in some sense be a justified one ... *Provided however that the claim of proprietorship is made in good faith and is not rebutable on the ground that in fact someone else was the proprietor, it is difficult to see how it can be objected to*. (Emphasis added.)

[54] I am of the considered opinion that the bona fide of the defendant in filing the defendant's trade mark cannot be doubted. Its claim to ownership of the said mark is a justified one as it is essentially an encapsulation of the name and emblem of the Club since its establishment since 1911. The usage of the word 'polo' and the polo player devise is representative of the character of the club. Therefore, since the defendant's mark was created in 1911, whereby the plaintiff's earliest Polo mark was only registered in 1981, there is no possibility of the defendant copying the plaintiff's mark.

[55] The plaintiff relied on the case of *Re Vitamins Ltd's Application* [1956] RPC 1 where the application for registration was refused on the ground that the applicant had sought to register a mark with the knowledge that someone else had originated a similar mark.

[56] However, in *Vitamins Ltd's Application*, the subject matter is an identical trade mark, 'Pabalate'. In our present case, the defendant's mark is totally different to the plaintiff's Polo mark.

[57] The plaintiff also relied on the decision of the Court of Appeal in *Walton International Ltd v Yong Teng Hing (b/s Hong Kong Trading Co)* [2011] 5 MLJ 397; [2010] 8 CLJ 802 where the court said at p 406 (MLJ); p 813 (CLJ):

> [27] A person cannot be properly registered unless he is the proprietor of the mark. (see: *Re Hicks Trade Mark* [1897] 22 VLR 636). A proprietor is a person who at the moment he makes application to be registered to the exclusive use of the name or the mark, whether he then or before publicly adopted it. *A man cannot be said to have adopted a name or a mark if someone else has done so before him*.

[58] In the above case, *Walton International Ltd* (CA), the trade mark in question is an identical mark, the 'GIORDANO' trade mark. In the present case, the defendant is not adopting the plaintiff's Polo trade mark. The defendant is seeking to register its own trade mark , which is totally and incredibly different from the plaintiff's trade mark.

[59] Therefore, premised on the reasons above, I upheld the following findings of the registrar:

I find no element of bad faith in the use of the word 'polo' in the Applicant's mark. The decision has also been made that the Applicant's mark is neither identical nor similar to any marks owned by other parties in respect of the stated goods and that the use of it for the said goods is not likely to cause confusion to the public. Therefore, there is no reason to prohibit the Applicant as the management company of the club from being the proprietor of the Applicant's mark in respect of the said goods in Malaysia. This means that the opposition under s 25(1) of the Act has failed.

Issue (iii): The registrar erred in failing to give substantial weight and due consideration to the plaintiff's goodwill and reputation

[60] The reputation and goodwill of a trader is extremely important given that it is the goodwill of a trader that will retain its customer base and attract or draw prospective customers to purchase the goods offered.

[61] In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217, it was held by Lord Macnaghten at p 223 that 'Goodwill' may be defined as the 'benefit and advantage of the good name, reputation and connection with a business, whether it is a business that provides services or manufactures and/or distributes certain products. In other words, goodwill is the attractive force that brings in custom'.

[62] The plaintiff submits that it has built its name and reputation in Malaysia from the date of first use of the Polo marks in 1981. Therefore, the registrar should have given due regard to the fact that the plaintiff has obtained extensive reputation and goodwill its business under the POLO marks as that is exactly what sets the plaintiff apart from other traders in the market. It is also the underlying reason behind the confusion that would be caused by the use and registration of the defendant's mark, as members of the trade and the public who have become so accustomed with the goods bearing the Polo marks originate from the plaintiff. As such, members of the trade and the public would be confused or deceived into believing that the goods distributed under the defendant's mark originate from the plaintiff or are associated with the plaintiff.

[63] However, I am of the considered opinion that since the plaintiff's marks are different from the defendant's mark, then the issue of the plaintiff's goodwill and reputation in its business relating to the 'POLO' marks is not relevant. This is because even if the plaintiff, as the proprietor of the 'POLO' mark, has substantial goodwill and reputation, that does not prohibit the defendant from registering the defendant's mark, as it is different from the plaintiff's Polo mark.

[64] The two marks are clearly distinguishable that members of the trade

and the public would not assume or be deceived that the goods bearing the defendant's mark could in any way be associated with the plaintiff's Polo mark.

Issue (iv): The registrar erred in allowing the defendant's mark to proceed to registration when the defendant has failed to discharge the onus of proof that its mark is distinctive of the defendant for goods in Classes 3 and 16

[65] The plaintiff submit that the defendant's mark cannot be said to be one that is adapted to distinguish the defendant's goods from the goods of other traders, in particular, the plaintiff, as members of the trade and public will assume that the defendant's goods originate from the plaintiff or that the defendant is associated with the plaintiff in some way despite the fact that no such association exists.

[66] However, I agree with the submission of the defendant that its mark has satisfied the distinctiveness test under s 10(2A) of the TMA 1976 for the following reasons:

(a) as the defendant's mark is in fact the emblem and the name of the Club, and that there is only one such 'Santa Barbara Polo & Racquet Club' known, that by itself makes it distinctive;

(b) that the 'Santa Barbara Polo & Racquet Club' is in fact a polo and racquet club which is actually located in Santa Barbara, USA. There would be no reason for any honest trader to use the same or similar mark;

(c) that when a customer saw or mentioned 'Santa Barbara Polo & Racquet Club', it can only be associated with the defendant and its mark. Further, none of the marks bearing the word 'polo' in the registry has any resemblance, either in look or sounds like the defendant's mark; and

(d) finally, through the actual use of the defendant's mark, the defendant's mark as acquired distinctiveness through use.

Issue (v): The registrar had erred in law and/or in fact in holding that use of the mark by the defendant is unlikely to damage the plaintiff's interests

[67] The plaintiff submits that by using a mark which is confusingly similar to the plaintiff's POLO marks, the defendant would inevitably cause damage to the plaintiff's interests in that sales of the plaintiff's goods would be wrongfully diverted to the defendant. Further, consumers would also attribute any fault or shortcoming in goods bearing the defendant's mark to the plaintiff despite the fact that the plaintiff has no control over goods bearing the defendant's mark.

[68] However, since the defendant's mark is not confusingly similar to the plaintiff's marks, and/or that there is no issue of the defendant's mark causing damage to the plaintiff's mark.

Issue (vi): The learned registrar erred in law and/or in fact In holding that the plaintiff has no right to prohibit other parties from using the word 'polo' if it is used in a fair manner

[69] The plaintiff submits that it is perfectly entitled to prohibit the use of a confusingly similar mark if there is a reasonable likelihood of confusion or deception among a substantial number of persons if the defendant were to use its mark in the course of trade.

[70] In his decision, the registrar has pointed out that the word 'polo' is an ordinary English word that has a specific meaning and hence the plaintiff could not prohibit others from using it in a fair manner. The registrar held as follows:

> The word 'polo' is not a word invented by the opponent; it is an ordinary English word describing a team sports played on horseback in which the objective is to score goals against the opposing party. Thus, even if the Opponent had already registered or had already used marks which contain the word 'polo' and/or the device of a polo player on horseback prior to the relevant date in respect of the same or similar goods with those of the Applicant, the Opponent has no right to prohibit other parties from using that word or any polo player device if it is in a fair manner.

[71] It is not in dispute that the word 'polo' is a common English word (see *The Polo/Lauren Co LP* case). Apart from the polo games as described by the registrar, the word 'Polo' also has a dictionary meaning of 'polo neck' garment with a collar.

[72] In *Eastman Photographic Materials Company, Ltd v Comptroller-General of Patents Designs and Trade Marks, Solio Case* [1898] AC 571; (1898) AC 571, it was held by Lord Herschell that:

> ... The vocabulary of the English language is a common property; it belongs alike to all; and no one ought to be permitted to prevent the other members of the community from using for purposes of description to a word which has reference to the character or quality of goods. (Emphasis added.)

[73] In *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] 4 SLR 816, the High Court held as follows:

> *... the word 'POLO' is commonly used in everyday language either as reference to the sports or to a particular T-shirts. It is settled that the courts are weary of allowing companies to monopolise words that are purely descriptive or used in everyday parlance* : *The European v The Economist Newspaper Limited* (1998) FSR 283 at 289 and

A *Mothercare UK Ltd v Penguin Books Ltd* (1988) RPC 113 at 123 ... (Emphasis added.)

[74] Premised on the cases above, I agree with the finding of the registrar that as the plaintiff did not invent the word 'Polo', it cannot prohibit the others from using the same.

Issue (vii): The registrar had erred in law and/or in fact in holding that the POLO marks are not well-known marks within the meaning of ss 14(1) and 70B of the Trade Marks Act 1976, read together with reg 13B of the Trade Marks Regulations 1997

[75] It is the submission of the plaintiff that its 'POLO' marks are clearly well known marks under article 6 *bis* of the Paris Convention and article 16 of the TRIPS agreement and are therefore protected under s 70B of the Act.

[76] Again, the plaintiff is making a sweeping statement that its POLO marks are clearly well known. The question is which specific mark is well known.

[77] The plaintiff's reliance on the decision by Justice Azhar Mohamad in *Dabur India Ltd v Nagasegi Sdn Bhd & Ors* [2011] 7 MLJ 522; [2011] 10 CLJ 134 is also misplaced, as the court there made a finding that the defendant's use of the trademarks 'INTAN PROMISE' and 'MISZWAK' is confusingly similar to the plaintiff's well known marks, namely the 'PROMISE' and 'MISWAK'.

[78] In the present case, apart from the fact that the plaintiff has failed to show which of its mark is a 'well known' mark, I also find that the defendant's mark is not identical with or confusingly similar to the plaintiff's elusive well known mark pursuant to Regulation 13A of the Trade Marks Regulation 1997.

Issue (viii): The registrar erred in falling to find that registration and/or use of the mark by the defendant would constitute passing-off in common law, contrary to s 82(2) of the Trade Marks Act 1976

[79] The plaintiff submits that the use of the defendant's mark in relation to the defendant's goods is calculated to deceive or cause confusion and will lead the goods distributed under the defendant's mark being passed off as, being mistaken for or associated with, the goods of the plaintiff.

[80] However, I am of the considered opinion that the registrar has no jurisdiction on issues of passing off. Whether there is a case that would constitute passing off is for the court to decide, and the plaintiff ought to

commence its case for passing off in the High Court. That is the purpose of s 82(2) of the TMA 1976, which reads:

> Notwithstanding subsection (1), nothing in this Act shaii be deemed to affect the right of action against any person for passing off goods or services as those of another person or the remedies in respect thereof.

CONCLUSION

[81] The plaintiff relied on its family of trademarks, but the only mark that is registered is the

. The plaintiff had not adduced any evidence to show actual use, as the invoices merely refer to polo shirts and pants. There is no actual use with respect to goods in the Classes 3 and 16.

[82] The defendant's mark is actually the full name of the Club; it refers to the Club, 'Santa Barbara Polo & Racquet Club' and no one else, least of all, the plaintiff. The defendant's mark is distinctive of the defendant. The defendant's mark is also visually and phonetically different from the plaintiff's marks. As such, there can be no actual or likelihood of confusion or deception.

[83] As such, I find that there is no merit in the plaintiff's appeal and the same is dismissed with costs.

Appeals dismissed with costs.

Reported by Kohila Nesan